REMARKS

Claims 12 and 14-19 have been amended in order to insert the phrase "an effective amount of".

Claims 20-26 have been amended in order to list specific diseases/pathologies that are improved by β_3 agonist activity. Support for this amendment occurs for example, on page 11, lines 5-14 of the specification.

Claims 1-13 were in the application as filed. Claim 13 was cancelled and new claims 14-26 were added in the Preliminary Amendment filed on March 6, 2002. Claims 1-12 and 14-26 remain in the application.

It is noted that the Examiner has not yet received a certified copy of application FR 9911204, filed September 8, 1999, from the International Bureau and, accordingly, applicants are enclosing herewith a certified copy of this application for the Examiner's convenience.

Claims 12 and 14-19 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In support of this rejection the Examiner has stated that:

> Please note that claims 12, 14-19 are drawn to pharmaceutical compositions without dosage limitation. Thus the claims are self conflicting since a pharmaceutical composition *must not* be either ineffective or toxic. It is recommended that the dosage of "therapeutically effective amount" be incorporated into the claims.

This objection is believed to be overcome and should be withdrawn in view of the above-described amendments to claims 12 and 14-19 in which the phrase "an effective amount of" has now been incorporated into the claims.

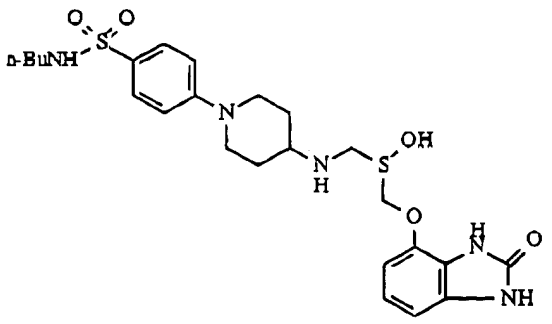
Claims 20-26 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In support of this rejection the Examiner has stated that:

> Initially, it is noted that the method are drawn to β_3 agonist action. The β_3 without proper identification is unclear of what is the action site. It is recommended that adrenergic β_3 receptor agonist be explicitly pointed out.
>
> Further, it is not clear "what" is the claimed scope encompassing treating pathologies that are "*improved*". A pathology can be treated by reverse the pathology i.e. treating the etiology of the pathology or disease, or the "symptom" of a pathology can be relieved by treatment i.e. fever of a cold. It is unclear what does the scope of "*improved*" is referring to. It is recommended that specific disease/pathology be pointed out and how such pathology can be changed be incorporated i.e. treating irritable bowel syndrome by an agonistic activity of the compound of the adrenergic β_3 receptor on colon smooth muscle.

This rejection is believed to be overcome and should be withdrawn in view of the above described amendments to claims 20-26 which now specifically list various diseases/pathologies that are improved by β_3 agonist activity.

Claims 1, 10-11, 12 and 20 are rejected under 35 U.S.C. §102(a), (e) or (g) as being anticipated by Sum et al., U.S. Patent No. 6,444,685. In support of this rejection the Examiner has stated that:

> The Sum reference is a 102(a) reference (publication date) against the instant application date, a 102(e) reference (provisional date) against the instant application date and a 102(g) reference against the instant 371/PCT application date.
>
> Sum et al. '685 disclosed compounds anticipated the claims and one structure is delineated as following:



which anticipate claim 1 when A is formula (a), Y_1 and Y_2 are NH, an and m are 0, X is CH, R_2 is $SO_2NR_3R_4$, R_3 is H, R_4 is butyl, thus anticipated every element of the claim. This compound (see claim 4, col. 66, line 7-9) it is composition and method of inhibiting type II diabetes, atherosclerosis etc. (see claims 5-10) anticipated the instant claims.

This rejection is traversed and reconsideration and withdrawal thereof are requested for the reasons given hereinbelow.

Initially, it is pointed out that since applicants have now provided the Examiner with a certified copy of French application No. 9911204, filed September 8, 1999, applicants are entitled to their claim of foreign priority benefit from this application under 35 U.S.C. §119. Thus, as the September 8, 1999 filing date of FR 9911204 is prior to even the July 17, 2000 filing date of U.S. provisional application No. 60/218,589, from which U.S. Patent No. 6,444,685 claims priority, U.S. Patent No. 6,444,685 would not be available as a reference under 35 U.S.S.§§102(a), 102(e) or 102(g) against the instant application.

Claims 1-5, 8, 10-11, 14-17, 20-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sum et al. '685 in view of Steffan et al. U.S. 6,506,901. In support of this rejection the Examiner has stated that:

> Sum et al. '685 disclosed compounds that anticipated the claims which were pointed out supra. Broadly, Sum et al. '685 disclosed variations of compounds wherein the benzimidazolone can be other aromatic moieties see col. 65-69 claim 4 and the X is CH.
>
> Sum et al. '685 disclosed all the elements of the claims **except** the X is N aromatic ring of the instant claim were not found. Steffan et al. '901 is analogous art wherein similar compounds have been disclosed for treating type II diabetes. Steffan et al. '901 taught the

variation of Sum in R1 being aromatic and particularly exemplified that both phenyl and pyridyl are optional choices for such compounds (see col. 149-150).

One having ordinary skill in the art is deemed to be aware of all the pertinent art in the field. The above references placed the generic teaching of the analogous compounds in the possession of artisan in the field. One in possession of the above references would be motivated to employ the pyridinyl moiety (Steffan '901) wherein the phenyl has been employed (Sum '685) **because** the modification of a *proven* compound using *attributes* of another proven compound having analogous activity is prima facie obvious. With the particular side by side exemplification of switching pyridinyl moiety with phenyl moiety (see Steffan '901) the explicit suggestion and reasonable expectation of success of such modification has been disclosed in the prior art.

This rejection is traversed and reconsideration and withdrawal thereof are requested for the reasons given hereinbelow.

As noted above, Sum et al., U.S. Patent No. 6,444,685 is not available as a reference against the instant application. Furthermore, since applicant's September 8, 1999 foreign priority date is prior to even the July 17, 2000 filing date of U.S. provisional application No. 60/218,753, from which Steffan et al., U.S. Patent No. 6,506,901 claims priority, U.S. Patent No. 6,506,901 would also not be available as a reference against the instant application.

Claims 6-7 are objected to for being dependent upon a rejected base claim. This objection is traversed and reconsideration and withdrawal thereof are requested for the reasons given hereinbelow.

Initially, applicants would point out that claims 6 and 7 are independent claims and, hence, can not possibly depend from a rejected base claim. As the rejection of claim 1, from which claim 9 depends, is believed to be overcome, the objection to claim 9 is rendered moot and should be withdrawn.

In view of the foregoing amendments and remarks, reconsideration and withdrawal of: (a) the rejection of claims 12 and 14-19 and under 35 U.S.C. §112, second paragraph, (b)

the rejection of claims 20-26 under 35 U.S.C. §112, second paragraph, (c) the rejection of claims 1, 10-11, 12 and 20 under 35 U.S.C. §102(a), (e) or (g), (d) the rejection of claims 1-5, 8, 10-11, 14-17 and 20-24 under 35 U.S.C. §103(a), and (e) the objection to claims 6, 7 and 9 is requested and the allowance of claims 1-12 and 14-26 is respectfully requested.

Respectfully submitted,

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